

REMARKS/ARGUMENTS

The application has been amended to correct the cited informalities, to distinguish the invention over the cited prior art, and to place the application, as a whole, into a *prima facie* condition for allowance. Care has been taken to avoid the introduction of any new subject matter into the application as a result of the foregoing amendments.

The specification has been objected to for allegedly failing to provide proper antecedent basis for the claimed subject matter. In particular, the Examiner cited Claims 1 and 18 as specifying "the mounting member being unattached to 'other supporting structures'" purportedly without an adequate description or disclosure of "other supporting structures".

In response thereto, Applicant respectfully submits that the Examiner's reference to Claim 18 appears incorrect. Instead, the Examiner's objection should be directed to Claim 11 because Claim 11, and not Claim 18, recites the language objected to by the Examiner. Insofar as Claims 1 and 11 recite the language objected to by the Examiner, Applicant respectfully submits that the phrase "unattached to other supporting structures" is duplicative to, and inherent in, the phrase "operably configured" in defining a structure that facilitates the manual handling, inspection and demonstration of the article, so that the claimed structure is neither broadened nor limited by its presence in Claims 1 and 11. Accordingly, Applicant has deleted the phrase "and unattached to other supporting structures so as to be" in the element beginning, "the mounting member being sized..." in both Claim 1 and 11. Reconsideration and withdrawal of the Examiner's objection to the specification is respectfully solicited.

Claims 1 - 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson, U.S. 6,123,306, in view of Burriss, U.S. 4,615,597, and in further in view of Goodman, U.S. 5,241,297.

The Jackson reference is directed to a camera mount for a wheelchair. There is no teaching or suggestion for providing a sensor to prevent theft of the camera from the wheelchair, as this device is unlikely to be used in a situation where the camera is going to be left unattended. The padlock (E) does nothing to teach security of attaching an article to a mounting plate, because the camera may be removed from the admittedly conventional tripod head through the usual means of unscrewing the screw, completely bypassing the padlock. The padlock merely affixes the hinged arm to the camera stand. There is nothing in Jackson that shows or suggests the provision of a security monitoring sensor at the tripod head, where the article (a camera) is attached.

The Burriss reference is directed to a movie camera mount to aid in filming the activities of actors inside automobiles. There is no need for a sensor to prevent theft of the movie

camera, because a movie camera mounted to a car is highly unlikely ever to be left unattended so as to require a theft-prevention sensor. In addition, a movie camera mounted to a car is not intended to be purchased from a retail vendor - the camera, after all, is rigidly mounted to a car so as to enable the filming of events occurring in and around the interior of a car toward the production of a movie. Furthermore, all of the areas on the mounting plate are for the variable affixation of the camera, so as to suit the needs of varying installation configurations, and so a sensor, positioned in the manner suggested by the examiner, would obstruct this highly variable configuration capability. Accordingly, there is nothing in Burriss that shows or suggests the provision of a security monitoring sensor for the movie camera.

The Goodman reference is directed to a security base for articles such as works of art, like a vase, jewelry or the like, where the article is on static display and not in use and where the article is clearly not meant to be picked up and handled (e.g. for close visual inspection). The anti-theft security base is configured simply to have the article placed on top of, or leaning against (in the case of a painting) the base and not affixed to the base. In this way, the article being monitored merely depresses the security plunger to activate the alarm. Indeed, this reference teaches against the affixation of the article to the base, because that would be potentially damaging to an article such as a vase, or other work of art, or jewelry. Indeed, the base is contemplated as something that should not be picked up, because even slight movement of the article/base could cause separation of the articles, thus causing actuation of the alarm. See Goodman, U.S. 5,241,297, Col. 1, lines 5-15, and Col. 3, lines 40-56. Indeed, an alternative embodiment includes a separate tilt sensor which likewise precludes contemplation of lifting.

Applicant also respectfully traverses the Examiner's purported combination of references, and respectfully submits that the proposed combination of the Jackson and Burriss references with the Goodman is inappropriate, and against the teachings of the respective references.

Two or more references may not be combined to support an assertion of obviousness of a claimed invention absent a teaching or suggestion to their combination. Further, two or more references may not be properly combined, if to do so would frustrate the functions, goals or purposes of one or more of the respective references.

Applicant respectfully submits the proposed combination of the Jackson and Burriss references with the Goodman reference has been posed, notwithstanding the complete absence of any teaching or suggestion in any of these altogether different references, to such combination. Combining the cited references in an attempt to reconstruct Applicant's invention,

with the benefit of the hindsight afforded by Applicant's own disclosure, would deviate from the teachings of the cited references. Applicant respectfully submits that it is not obvious to combine the cited references without having access to the application that is under examination to arrive at the claimed invention.

Neither the Jackson nor the Burris reference is directed to an apparatus for the monitoring of an article that is on display for sale in a retail setting. Both of these references disclose mounting structures for supporting, specifically, a camera while the camera is actively in use by authorized users of the equipment. There is no teaching or suggestion in either reference for affixing an anti-theft monitoring device for providing an indication that the article has been removed, or that an attempt has been made to remove it by a would-be thief. The apparatus of the Goodman reference, while directed to a monitoring device, likewise not only does not teach the affixation of a monitoring device to the article, it affirmatively teaches against it. As mentioned above, because the articles which the Goodman apparatus monitors are works of art or fine articles for sale (e.g., jewelry and the like), positive affixation of the sensor to the articles themselves in the manner suggested, is frustrated. As such there is no teaching in Goodman for any kind of positive mounting structure to affix a sensor to an article. Therefore, not only is there no teaching for the combination of the Jackson and Burris references with the Goodman reference, there is no teaching or suggestion in any of the references to the affirmative affixation of a sensor to an article being monitored -- even with the combination.

In addition, the Examiner must evaluate the claims as a whole, and may not use the claims as a roadmap for finding prior art that might render the claims obvious. See *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Applicant respectfully submits that, rather than evaluating the claims as a whole, the Examiner has inappropriately used the claims in the present invention as a template for dissecting unrelated prior art, and used the dissected pieces as a basis for issuing the rejection of Claims 1-20 under 25 U.S.C. §103(a). The Examiner's arguments, beginning on page 3 of the Office Action, illustrate just this dissection, resulting in a contradictory conclusion regarding the structure of Applicant's device. For example, the Examiner asserts on page 3 of the Office Action that Jackson discloses a mounting member that is "unattached to other supporting structures (i.e. as shown in Fig. 1 unattached to wheelchair shown in phantom)" in order to show that Jackson contemplates a camera mounting member that is unattached to other supporting structures, as required by Claims 1 and 11 of Applicant's invention. However, inapposite to this structure, the Examiner asserts on page 4 of the Office Action that "Jackson further teaches a lock for preventing unauthorized removal of the mount assembly (100) from its support (A), ..." (emphasis added). Clearly, the camera mounting

apparatus in Jackson is fully supported at all times by a wheelchair, or the entire device does not work. In fact, the title of the Jackson '306 reference, along with the Abstract, the specification, and drawings -- all suggest a structure that attaches a camera on a rigid stand where the stand itself is further supported by a wheelchair. Accordingly, Applicant respectfully submits that the Examiner improperly used the claims in the present invention as a roadmap for dissecting Jackson, and in doing so, improperly analyzed the structure of Applicant's invention as a whole.

In another example in which Applicant respectfully submits that the Examiner improperly dissected and applied prior art, the Examiner asserts on page 3 of the Office Action that Burriss discloses an "article attachment region (at A and C), a lower surface, and a centrally located sensor region (B) distinct from the article attachment region and including isolated apertures/recessed areas (18) displaced and segregated from a plurality of apertures in the article attachment region (at A and C)..." In support of the assertion that Jackson, in combination with Burriss, renders Applicants' invention obvious, the Examiner has: (1) modified Burriss to include three "zones" A, B, and C corresponding to a first aperture region, a sensor region, and a second aperture region, respectively, and (2) stated that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the mounting member (55) in include a plurality of threaded apertures (A, B, C) because one would have been motivated to permit selective positioning of the article on the mounting member as inherently taught by Burriss." However, just because prior art *may be* modified as suggested by an Examiner does not mean that the modification is obvious, unless the prior art suggests the desirability of the modification. See *In re Fritch*, 972 F.2d at 1266 (quoting *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984)). Applicant respectfully submits that one of ordinary skill in the art at the time the invention was made would not be motivated to make the modification of the Burriss device, as suggested by the Examiner, because Burriss is directed to a device that neither contemplates, nor requires, (a) multiple mounting orientations of a mounting member to an article to be monitored, (b) electronic theft prevention, and (c) flexibility in handling of the article being monitored separate and apart from any supporting structure. Accordingly, Applicant respectfully submits that the Examiner improperly used the claims in the present invention as a roadmap for dissecting Burriss, and in doing so, improperly analyzed the structure of Applicant's invention as a whole.

Notwithstanding the foregoing traversal of the Examiner's combination of references, even if the references were to be combined, the resulting combination would not teach or suggest Applicant's invention of amended Claims 1 and 11. Applicant respectfully submits that

none of the Jackson, Burriss, or Goodman references teaches or suggests a universal mount assembly incorporating the structure of amended Claims 1 and 11 as described below.

Applicant's invention of amended Claims 1 and 11 each include the limitations of a mounting member that has a plurality of apertures for enabling restrainable and adjustable affixation of the mounting member to an article being monitored. Applicant respectfully submits that the Goodman reference does not teach "affirmative attachment" with the article being monitored as the Examiner has asserted on page 7 of the Office Action. The Examiner has apparently interpreted "affirmative attachment" to mean that the sensor is in "continuous contact with the article". (See page 7 of the Office Action.). However, the 1993 edition of The New Shorter Oxford English Dictionary On Historical Principles defines "attachment" as "Something attached, or intended to be attached; an adjunct ... The action of fastening, joining, affixing, or attributing; the condition of being fastened etc..." Lesley Brown, Clarendon Press – Oxford, Volume 1 A-M, (1993). Accordingly, Applicant respectfully submits that the Examiner's use of the term "attachment" is incorrect when used to encompass "continuous contact with the article" because the term "attachment" is limited to that which is affirmatively fastened, joined or affixed, and not merely something that is placed in contact with something else. Nevertheless, Applicant has amended Claims 1 and 11 to include the limitation that the mounting member is affixed to the article being monitored to exclude mere contact with the article being monitored. Such a structure is unquestionably absent in Goodman.

In addition, amended Claims 1 and 11 include the limitation that the holes used for securing the mounting member to the article being monitored be non-threaded, as opposed to threaded holes, a structure that is potentially disclosed in Burriss, but not in Jackson or Goodman. Support for this change is found in Figs. 1 - 8. Applicant respectfully submits that no new matter has been introduced as a result of any of the above amendments to the claims.

In view of the foregoing, Applicant submits that Applicant's invention of amended claims 1 and 11, should be deemed to patentably distinguish over the cited Jackson, Burriss, and Goodman references, whether taken alone or in combination with one another, as well as over the remaining cited prior art of record. Accordingly, reconsideration and withdrawal of the rejection of claims 1 and 11 and allowance thereof, are respectfully solicited.

Inasmuch as dependent claims 2 - 10 and 12 - 20 merely serve to further define the subject matter of amended claims 1 and 11, respectively, which themselves should be deemed allowable, claims 2 - 10 and 12 - 20 likewise should be deemed to patentably distinguish over the cited prior art of record. Reconsideration and withdrawal of the rejections of claims 2 – 10 and 12 - 20 and allowance thereof are respectfully solicited.

Applicant submits that the application as a whole, including all of claims 1 - 20, is in a *prima facie* condition for allowance at this time, and such allowance is respectfully solicited.

Should anything further be required, a telephone call to the undersigned at (312) 456-8400 is respectfully requested.

Respectfully submitted,

GREENBERG TRAURIG

Dated: 6/1/04


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 6/3/04


Thomas E. Williams